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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/002,276    12/31/97    CRIM    S    97-500

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EXAMINER

MCCARTY, W

ART UNIT

PAPER NUMBER

2761

DATE MAILED:

07/19/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/002,276

Applicant(s)

Crim et al.

Examiner

McCarty

Group Art Unit

2761



☒ Responsive to communication(s) filed on May 2, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 7-16, 22-31, and 37-48 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 7-16, 22-31, and 37-48 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

This communication is responsive to the Applicant's amendment (paper no. 7) of application **09/002,276** filed December 31, 1997. The amendment, filed May 02, 2000, amends claims 7, 22, and 37, and cancels claims 1-6, 17-21, and 32-36. Accordingly, claims 7-16, 22-31, and 37-48 remain pending and are presented for examination on their merits.

#### ***Allowable Subject Matter***

1. The indicated allowability of claims 13-16, 28-31, 43-48 is withdrawn in view of the claim rejections rendered hereinbelow under 35 USC 112, second paragraph. Rejections of the relevant claims follow.

#### ***Response to Arguments***

2. Applicant's arguments with respect to claims 7, 22, and 37 have been considered but are moot in view of the new ground(s) of rejection.

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***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 7-16, 22-31, and 37-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In all independent claims, the Applicant recites language concerning codes which indicate a set of products. However, within the specification the Applicant refers to such codes as indicating specific product providers. Please see specification page 4, lines 21-22; page 5, lines 5-6; and page 40, lines 21-22. The mix of terms leads to a confusing reading of the claims. Please clarify

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 7-12, 22-27, and 37-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,799,156 to *Shavit et al.* in view of U.S. Patent No. 5,222,120 to *McLeod et al.*

As to **claim 7**, *Shavit* discloses a *method for processing requests for products* (processing of business transactions; col. 1, lines 1-12) comprising: *receiving a request identifying a customer* (user profile is extracted from the data base upon initial access, leading to authorization of service request which evolves to a RFQ; col. 10, lines 1-30; col. 12, lines 54-60); *converting portions of the received request into a set of provisioning requests* (converting an RFQ to an order, either as is or with modification; col. 13, lines 62-63); and *providing the provisioning request to the provider* (transmitting order to distributor via authorization inquiry; col. 14, lines 1-4; computer communication to distributor; col. 14, line 64 - col. 15, line 17). However, *Shavit* does not explicitly disclose *storing in a database a set of bundle codes, each bundle code indicating a set of products offered by a provider; receiving a request including a bundle code; and converting portions of the received request into provisioning requests based on the received bundle code.* *McLeod* discloses *storing in a database a set of bundle codes, each bundle code indicating a set of products offered by a provider; receiving a request including a bundle code; and converting portions of the received request into provisioning requests based on the received bundle code* (enhanced services are specified by user via a selection code. *McLeod*: col. 2, lines 29-64. See also item 282 of Fig. 10A; col. 21, line 30. A plurality of product bundles as well as a plurality of providers can be inferred from col. 16, lines 23-26). Therefore, it would have been obvious to one

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of ordinary skill in the art at the time the invention was made to use the bundle code teachings of *McLeod* with the request processing of *Shavit*. The motivation for this combination suggests itself from the disclosure of *Shavit* which teaches use of a code name for selected services (col.10, lines 61-65). The language of *Shavit* at col.10, lines 61-65, states that the user may further include the selected service provider along with the branch to the selected service, which implies that a plurality of service providers are available to the user unless a specific one is designated. This plurality of service providers, therefore, is available through the code name for the selected service and thus suggests the limitation of the Applicant's claim recitation directed to a *bundle code* and use thereof. By providing a bundle of product offerings, customer convenience can be realized due the "one-stop-shopping" nature of bundled products (see "Saville Provides Time Warner Communications With Saville CBP Billing Platform", p.1, lines 19-23; p.2, line 52; p.3, lines 1-3).

As to **claim 8**, *Shavit* discloses the *method of claim 7, wherein the converting step includes the substep of deciphering the bundle code to identify the plurality of providers for the selected products* (col.10, line 61-65). Deciphering the code name to ascertain the selected service, and the plurality of providers contained therein, is an obvious function of using a code value because the information that the code value represents will have to be extracted in order to be utilized.

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As to **claim 9**, *Shavit* discloses the *method of claim 7, wherein the step of providing the provisioning request to the provider includes the substep of storing information from the received request as a customer record* (transactions stored; col. 11, lines 22-24; claim 28; col. 39, line 25).

As to **claim 10**, *Shavit* discloses the *method of claim 7, wherein the step of providing the provisioning requests to the providers includes the substep of determining a means for providing each of the provisioning requests to the providers* (choice available between on-line and manual transaction; col. 15, lines 45-60).

As to **claim 11**, *Shavit* discloses the *method of claim 10, wherein the step of providing the provisioning requests to the providers includes the substep of electronically transmitting or physically delivering the provisioning requests to the providers based on the determination* (computer communication to distributor; col. 14, line 64 - col. 15, line 17; manual intercept; col. 15, lines 48-51).

As to **claim 12**, *Shavit* discloses the *method of claim 8, wherein the deciphering step includes the substep of selecting product codes corresponding to the received bundle code from a stored table* (searching a catalog by using multiple keys suggests use of product codes (col. 15,

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lines 51-60). Additionally, it is well known in the art of which the Applicant's invention is concerned that catalogs display products identified by product codes. Claim 33, col.40, line 7, discloses use of a seller catalog, from which it can be inferred that product code identifiers are utilized). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use product codes corresponding to the received bundle code identifying a plurality of providers such that *the deciphering step includes the substep of selecting product codes corresponding to the received bundle code from a stored table*. This is obvious because product codes are a well established means of identifying products and therefore it would follow that each of the plurality of providers in the bundle would utilize their own associated product codes.

As to **claim 22**, *Shavit* discloses a *billing controller for processing requests for products* (interactive market management system [50]; col.5, lines 17-18+; claim 1; col.37, lines 34-48) *comprising: a receiver configured to receive identifying a customer* (user profile is extracted from the data base upon initial access, leading to authorization of service request which evolves to a RFQ; col.10, lines 1-30; col.12, lines 54-60); *a converter configured to convert portions of the received request into provisioning requests* (converting an RFQ to an order, either as is or with modification; col.13, lines 62-63); and *a component configured to provide the provisioning request to the provider* (transmitting order to distributor via authorization inquiry; col.14, lines 1-4; computer communication to distributor; col.14, line 64 - col.15, line 17). However, *Shavit*



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does not explicitly disclose *a database configured to store a set of bundle codes, each bundle code indicating a set of products offered by a provider; a receiver configured to receive a request including a bundle code; and a converter configured to convert a portion of the received request into a set of provisioning requests based on the received bundle code*. *McLeod* discloses *a database configured to store a set of bundle codes, each bundle code indicating a set of products offered by a provider; a receiver configured to receive a request including a bundle code; and a converter configured to convert a portion of the received request into a set of provisioning requests based on the received bundle code* (enhanced services are specified by user via a selection code. *McLeod*: col.2, lines 29-64. See also item 282 of Fig.10A; col.21, line 30. A plurality of product bundles as well as a plurality of providers can be inferred from col.16, lines 23-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the bundle code teachings of *McLeod* with the request processing of *Shavit*. The motivation for this combination suggests itself from the disclosure of *Shavit* which teaches use of a code name for selected services (col.10, lines 61-65). The language of *Shavit* at col.10, lines 61-65, states that the user may further include the selected service provider along with the branch to the selected service, which implies that a plurality of service providers are available to the user unless a specific one is designated. This plurality of service providers, therefore, is available through the code name for the selected service and thus suggests the limitation of the Applicant's claim recitation directed to a *bundle code* and use thereof. By providing a bundle of product offerings, customer convenience can be realized due the "one-stop-

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shopping” nature of bundled products (see “Saville Provides Time Warner Communications With Saville CBP Billing Platform”, p.1, lines 19-23; p.2, line 52; p.3, lines 1-3).

As to **claim 23**, *Shavit* discloses the *billing controller of claim 22, wherein the converter includes a decoder configured to decode the bundle code to identify the plurality of providers for the selected products* (col.10, line 61-65). Deciphering the code name to ascertain the selected service, and the plurality of providers contained therein, is an obvious function of using a code value because the information that the code value represents will have to be extracted in order to be utilized.

As to **claim 24**, *Shavit* discloses the *billing controller of claim 22, wherein the component configured to provide the provisioning request to the provider includes storage configured to store information from the received request as a customer record* (transactions stored; col.11, lines 22-24; claim 28; col.39, line 25).

As to **claim 25**, *Shavit* discloses the *billing controller of claim 22, wherein the component configured to provide the provisioning requests to the providers includes a component configured to determine a means for providing each of the provisioning requests to the providers* (choice available between on-line and manual transaction; col.15, lines 45-60).

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As to **claim 26**, *Shavit* discloses the *billing controller of claim 22, wherein the component configured to provide the provisioning requests to the providers includes a transmitter configured to electronically transmit the provisioning requests to the providers* (computer communication to distributor; col.14, line 64 - col.15, line 17).

As to **claim 27**, *Shavit* discloses the *billing controller of claim 23, wherein the decoder includes means for selecting product codes corresponding to the received bundle code from a stored table* (searching a catalog by using multiple keys suggests use of product codes (col.15, lines 51-60). Additionally, it is well known in the art of which the Applicant's invention is concerned that catalogs display products identified by product codes. Claim 33, col.40, line 7, discloses use of a seller catalog, from which it can be inferred that product code identifiers are utilized). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use product codes corresponding to the received bundle code identifying a plurality of providers such that *the decoder includes means for selecting product codes corresponding to the received bundle code from a stored table*. This is obvious because product codes are a well established means of identifying products and therefore it would follow that each of the plurality of providers in the bundle would utilize their own associated product codes.

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As to **claim 37**, *Shavit* discloses a computer program product comprising a computer usable medium having computable readable code embodied therein for processing requests for products (interactive market management system [50]; col.5, lines 17-18+; claim 1; col.37, lines 34-48), the computer usable medium comprising: a receiving module configured to receive identifying a customer (user profile is extracted from the data base upon initial access, leading to authorization of service request which evolves to a RFQ; col.10, lines 1-30; col.12, lines 54-60); a converting module configured to convert portions of the received request into provisioning requests (converting an RFQ to an order, either as is or with modification; col.13, lines 62-63); and a provisioning module configured to provide the provisioning request to the providers (transmitting order to distributor via authorization inquiry; col.14, lines 1-4; computer communication to distributor; col.14, line 64 - col.15, line 17). However, *Shavit* does not explicitly disclose a database configured to store a set of bundle codes, each bundle code indicating a set of products offered by a provider; a computer usable medium configured to receive a request including a bundle code; and a computer usable medium configured to convert a portion of the received request into a set of provisioning requests based on the received bundle code. *McLeod* discloses a database configured to store a set of bundle codes, each bundle code indicating a set of products offered by a provider; a computer usable medium configured to receive a request including a bundle code; and a computer usable medium configured to convert a portion of the received request into a set of provisioning requests based on the received bundle code (enhanced services are specified by user via a selection code. *McLeod*: col.2, lines 29-64.

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See also item 282 of Fig. 10A; col. 21, line 30. A plurality of product bundles as well as a plurality of providers can be inferred from col. 16, lines 23-26). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the bundle code teachings of *McLeod* with the request processing of *Shavit*. The motivation for this combination suggests itself from the disclosure of *Shavit* which teaches use of a code name for selected services (col. 10, lines 61-65). The language of *Shavit* at col. 10, lines 61-65, states that the user may further include the selected service provider along with the branch to the selected service, which implies that a plurality of service providers are available to the user unless a specific one is designated. This plurality of service providers, therefore, is available through the code name for the selected service and thus suggests the limitation of the Applicant's claim recitation directed to a *bundle code* and use thereof. By providing a bundle of product offerings, customer convenience can be realized due the "one-stop-shopping" nature of bundled products (see "Saville Provides Time Warner Communications With Saville CBP Billing Platform", p. 1, lines 19-23; p. 2, line 52; p. 3, lines 1-3).

As to **claim 38**, *Shavit* discloses the *computer program product of claim 37, wherein the converting module includes a module configured to decipher the bundle code to identify the plurality of providers for the selected products* (col. 10, line 61-65). Deciphering the code name to ascertain the selected service, and the plurality of providers contained therein, is an obvious

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function of using a code value because the information that the code value represents will have to be extracted in order to be utilized.

As to **claim 39**, *Shavit* discloses the *computer program product of claim 37, wherein the provisioning module includes a module configured to store information from the received request as a customer record* (transactions stored; col.11, lines 22-24; claim 28; col.39, line 25).

As to **claim 40**, *Shavit* discloses the *computer program product of claim 37, wherein the provisioning module includes a module configured to determine a means for providing each of the provisioning requests to the providers* (choice available between on-line and manual transaction; col.15, lines 45-60).

As to **claim 41**, *Shavit* discloses the *computer program product of claim 37, wherein the provisioning module includes a module configured to electronically transmit the provisioning requests to the providers based on the determination* (computer communication to distributor; col.14, line 64 - col.15, line 17).

As to **claim 42**, *Shavit* discloses the *computer program product of claim 38, wherein the deciphering module includes a module configured to select product codes corresponding to the received bundle code from a stored table* (searching a catalog by using multiple keys suggests use

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of product codes (col.15, lines 51-60). Additionally, it is well known in the art of which the Applicant's invention is concerned that catalogs display products identified by product codes. Claim 33, col.40, line 7, discloses use of a seller catalog, from which it can be inferred that product code identifiers are utilized). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use product codes corresponding to the received bundle code identifying a plurality of providers such that *the deciphering module includes a module configured to select product codes corresponding to the received bundle code from a stored table*. This is obvious because product codes are a well established means of identifying products and therefore it would follow that each of the plurality of providers in the bundle would utilize their own associated product codes.

### ***Conclusion***

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "A fair Share" by Jeff Morrow; "Putting it all together: Has one-stop shopping arrived?" by Patrick Flanagan; and "Saville Provides Time Warner Communications With Saville CBP Billing Platform" from Business Wire.

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7. Any inquiry concerning this communication from the Examiner should be directed to Will McCarty whose telephone number is (703) 305-0625.

8. Any response to this action should be mailed to:

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or faxed to:

(703) 308-9051, (for formal communications intended for entry)

Or:

(703) 305-0040 (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA., Sixth Floor (Receptionist).

  
Will McCarty  
July 16, 2000

  
EDWARD R. COSIMANO  
PRIMARY EXAMINER